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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|---|-------------|----------------------|---------------------------|------------------------|
| 10/528,207  | 03/17/2005  | Harald Hagen         | 11138-018                 | 4540                   |
| 757 7590 06/06/2007<br>BRINKS HOFER GILSON & LIONE<br>P.O. BOX 10395<br>CHICAGO, IL 60610 |             |                      | EXAMINER<br>RIPLEY, JAY R |                        |
|   |             |                      | ART UNIT<br>3679          | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>06/06/2007   | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/528,207 | <b>Applicant(s)</b><br>HAGEN, HARALD |  |
|                              | <b>Examiner</b><br>Jay R. Ripley     | <b>Art Unit</b><br>3679              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03/14/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/14/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were filed on 03/14/2007. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In regard to claim 1, it is recited in lines 4-6, "an externally threaded portion having an outer thread diameter configured for screwing into a threaded bore of a base having a surrounding surface adjacent to a mouth of the threaded bore"; the recitation indicating an intended use and not positively claiming the threaded bore and base part. However, in lines 18-19, the recitation of, "when the screw-in part is screwed into the threaded bore of the base part" appears to be positively claiming structure for the screw-in part based upon the non-positively structure of the threaded bore and base part.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Neuschotz (U.S. 3,212,796).

7. In regard to claim 1, Neuschotz, in Figure 4 below, discloses an adapter assembly comprising:

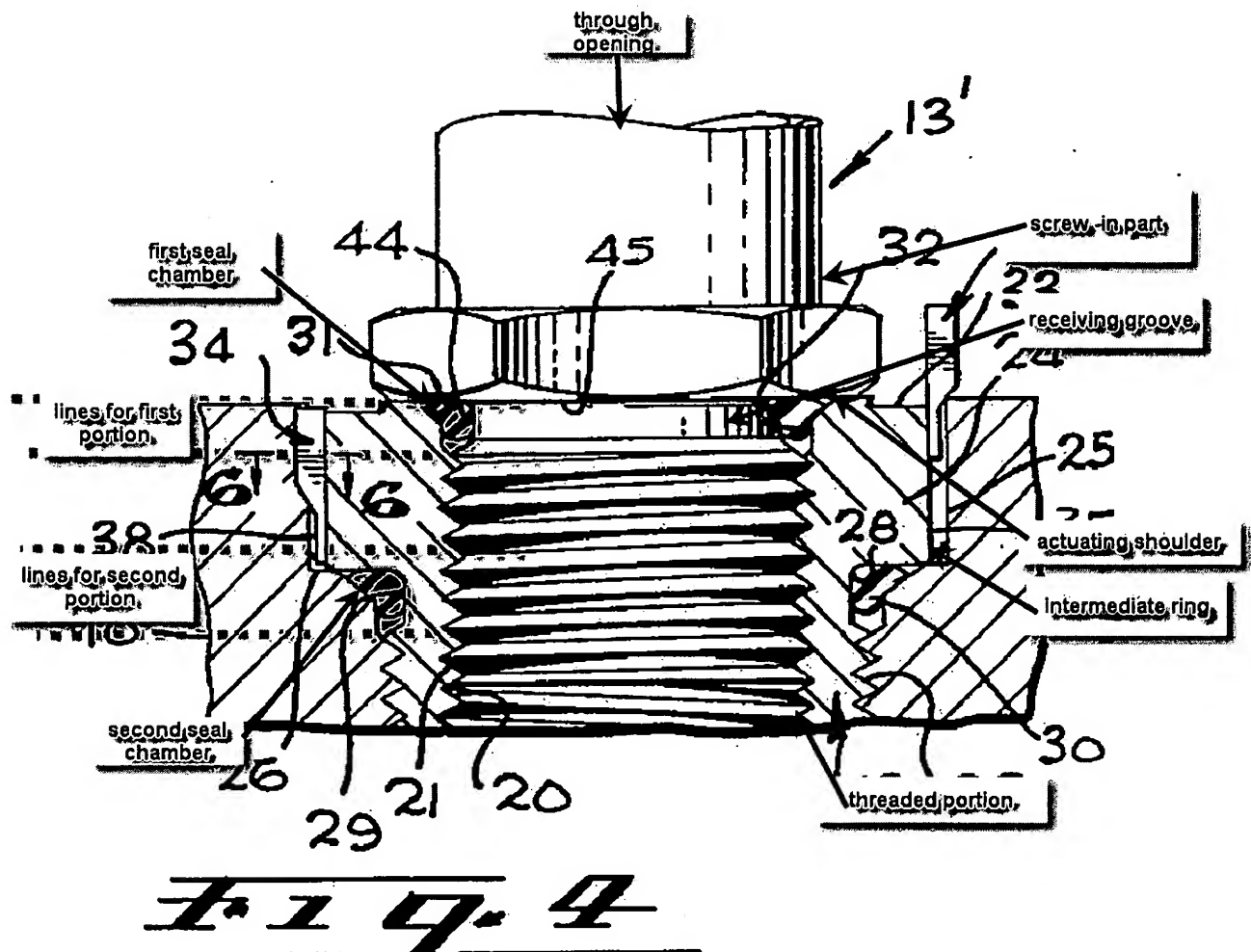
a screw-in part having a through-opening, an externally threaded portion having an outer thread diameter, an actuating shoulder having an outer shoulder diameter being larger than the thread diameter (as can be observed in Figure 4, below, the outer diameter of the actuating shoulder is diametrically further from the central axis than any of the threads shown), and a receiving groove formed in the transition between the actuating shoulder and the externally threaded portion and a first sealing ring being disposed in the receiving groove

the intermediate ring being adapted to fit onto the externally threaded portion (as observed in Figure 4 below, the intermediate ring is on the threaded portion of the screw-in part) and having first and second axially opposite annular planar portions (lines added to marked Figure 4's below to emphasize the portions),

the first planar annular portion having a first sealing ring seat on a first side facing the actuating shoulder, the first sealing ring seat (part 31) and the receiving groove and the actuating shoulder forming a first sealing chamber for the first sealing ring, and

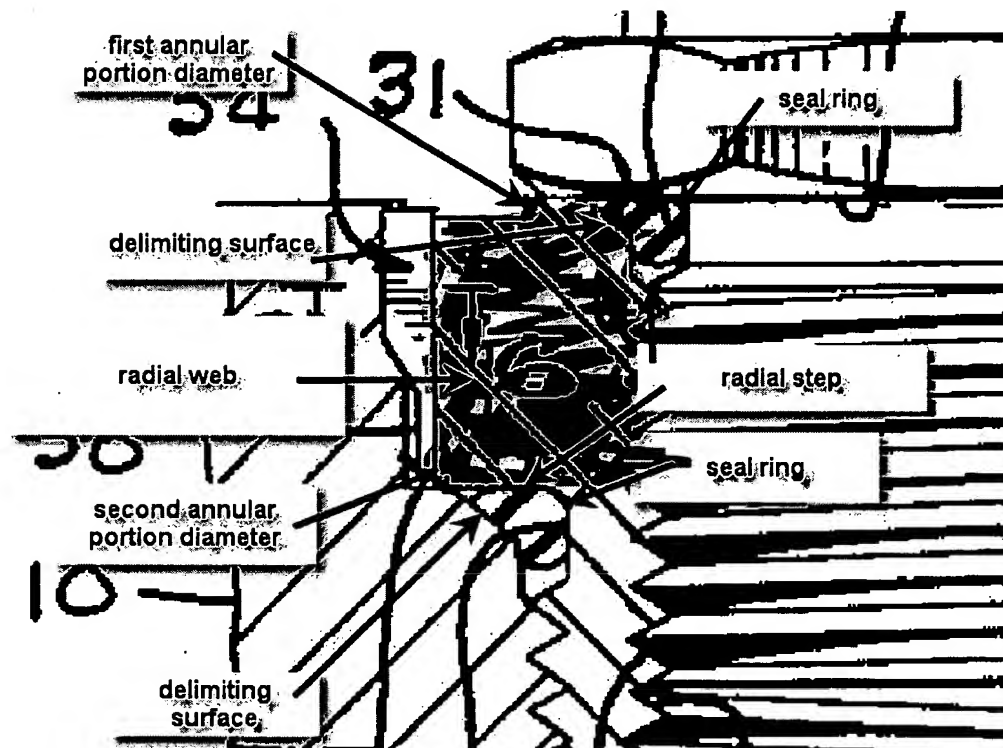
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the second planar annular portion having a planar second sealing ring seat on a side facing away from the actuating shoulder for a second sealing ring such that, when the screw-in part is screwed into the threaded bore of the base part, a second sealing chamber for the second sealing ring is formed between the planar second sealing ring seat, the surrounding surface adjacent the threaded bore, and the externally threaded portion of the screw in part.

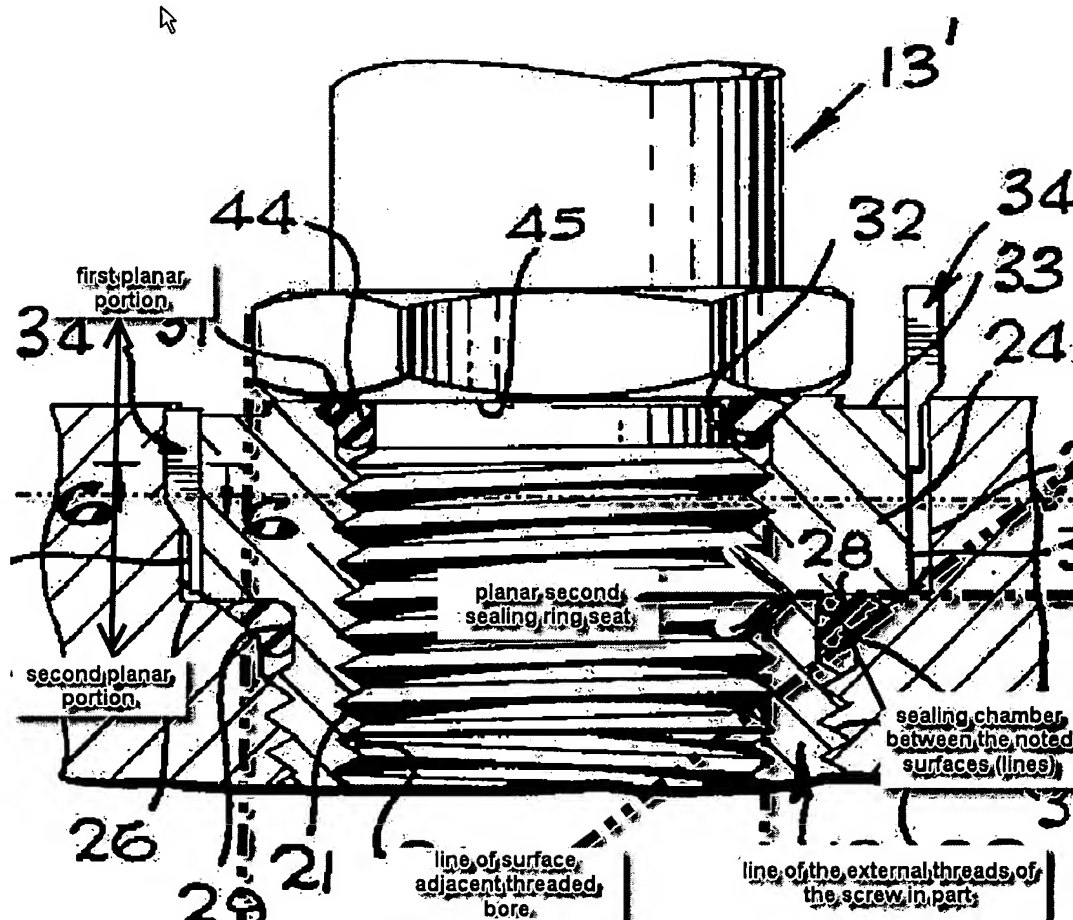


(marked Neuschotz Figure 4)

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(marked cut-out Neuschotz Figure 4)



(marked cut-out Neuschotz Figure 4)

8. In regard to claim 2, Neuschotz further discloses that the first and second sealing ring seats and the associated first and second sealing rings are formed such that, in a mounted state, the first and second sealing rings (as observed in marked cut-out of Figure 4, above) are compressed, the second sealing ring compressed axially without substantial radial deformation against the externally threaded portion (as can be observed in marked cut-out of Figure 4, the second seal ring does not contact the threads).

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9. In regard to claim 3, Neuschotz further discloses that the first and the second annular portions are separated by an internal radial web (as observed in marked cut-out of Figure 4 above), which divides the first and second seats from one another.

10. In regard to claim 4, Neuschotz further discloses that the intermediate ring sealing ring seats formed by a radial step surface and an approximately conically widening delimiting surface adjacent to it on the outside (as observed in marked cut-out of Figure 4 above).

11. In regard to claim 6, Neuschotz further discloses that the first annular portion is designed to be smaller in diameter than the second annular portion (as observed in marked cut-out of Figure 4 above).

12. In regard to claim 7, Neuschotz further discloses that the intermediate ring is metal (column 3, lines 13-16). Note, it is the patentability of the product, and not recited process steps, that is to be determined and thus how the intermediate ring was formed is of little consequence to the patentability determination of the final product. Neuschotz possesses an intermediate ring that meets the structure of the claim.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuschotz as applied to claims above, and further in view of Hagan et al (U.S. 6,027,144).



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15. In regard to claim 5, Neuschotz discloses the claimed invention except for a plug holding element. Hagan et al teaches an adapter assembly (in patent document Figure 8) with a plug holding element (12) to secure a plug against release (column 1, lines 10-15). As Hagan et al relate to adapter assemblies, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adapter assembly of Neuschotz with a plug holding element as taught by Hagan et al to secure a plug against release.

16. Further in regard to claim 5, the adapter assembly of Neuschotz is capable of being dimensioned such that a gap is formed between an end of a plug part and a bottom of a bore when the plug part is plugged into the screw-in part and engaged with the plug holding element.

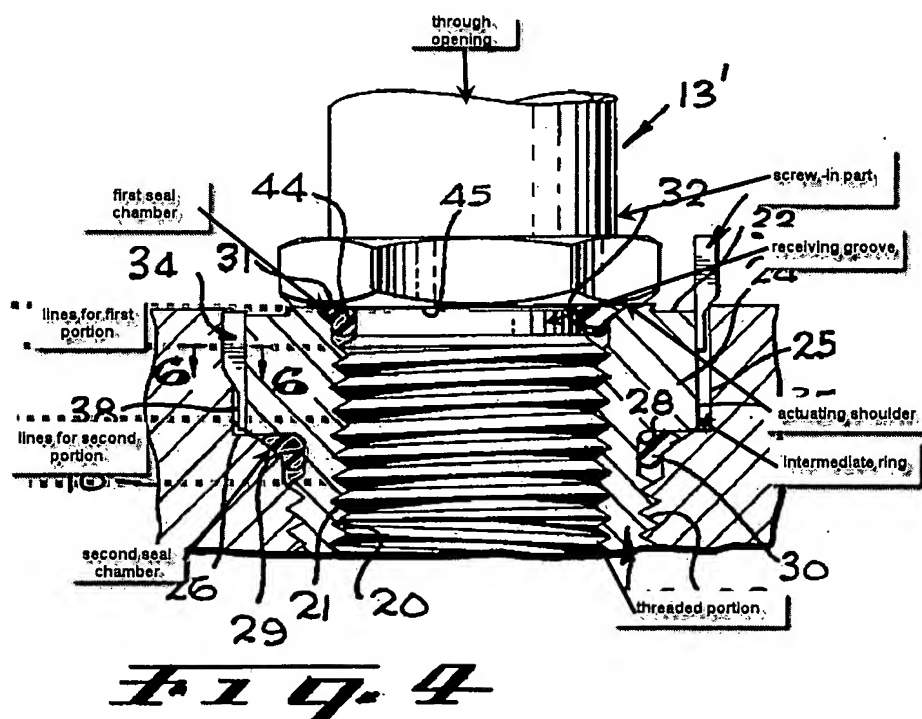
### *Response to Arguments*

17. Applicant's arguments filed 03/14/2007 have been fully considered but they are not persuasive.

18. In regards to the Applicant's arguments regarding the prior art of Neuschotz, the Applicant's arguments are not persuasive. Applicant argues that Neuschotz fails to disclose "an externally threaded portion having an outer thread diameter configured for screwing into a threaded bore of a base having a surrounding surface adjacent to a mouth of the threaded bore" as recited in lines 4-6 of claim 1. The recited phrase indicates an intended use as indicated by "configured for". The term "configured" is defined to mean: to design, arrange, set up, or shape with a view to specific applications or uses. The phrase "configured for" therefore is interpreted to mean capable of being so configured and as an intended use. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

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does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Neuschotz discloses the positively claimed structure of an externally threaded portion of a screw-in part as observed in Figure 4, below, and therefore the claim limitation is met. The argument is not persuasive.

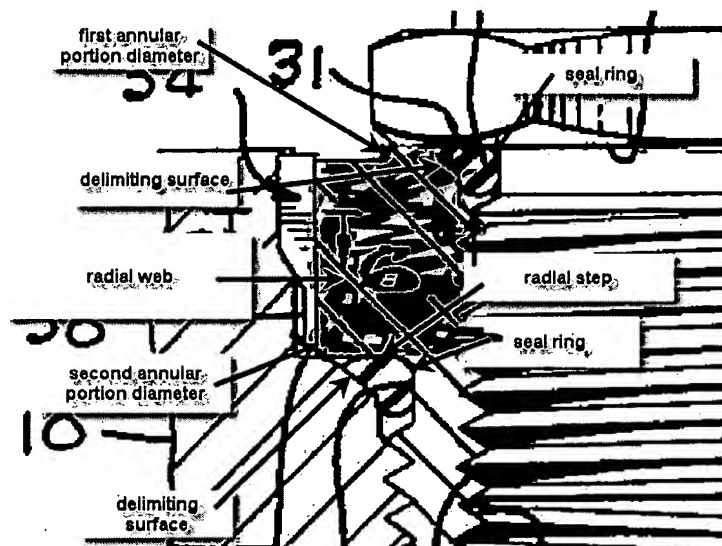


(marked Neuschotz Figure 4)

19. Further, the Applicant argues that Neuschotz fails to disclose that “a second sealing chamber the second sealing ring is formed between the planar second sealing ring seat, the surrounding surface adjacent the threaded bore, and the externally threaded portion of the screw in part” as recited in lines 20-23 of claim 1. Neuschotz discloses the claimed structural components, i.e. the planar second sealing ring seat, a surface adjacent the threaded bore, and the externally threaded portion of the screw in part. Further, it is noted that neither term “between” nor the term “adjacent” carry any particular requirements as to closeness of location. “Adjacent”

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means: lying near or close. "Between" means: in the position or interval separating. A broad interpretation does not ensure that the noted structural features are the physical boundaries of the second sealing chamber. Neuschotz discloses his second sealing chamber between the noted structural, as shown below in a cut-out of Neuschotz Figure 4. The Applicant's arguments are not persuasive.



(marked cut-out Neuschotz Figure 4)

### *Conclusion*

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

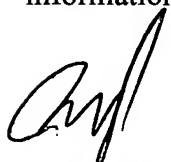
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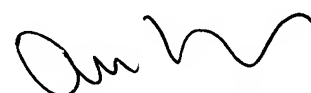
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay R. Ripley whose telephone number is 571-272-7535. The examiner can normally be reached on 6:00AM - 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
J. R. Ripley  
18 MAY 2007

  
AARON DUNWOODY  
PRIMARY EXAMINER  
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